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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,875	11/09/2001	Nicholas A. Thomas	9311.36	4335
21999	7590	03/03/2005	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 03/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/035,875

Applicant(s)

THOMAS ET AL

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/08/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/27/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-29 have been examined. Application 10/035,875 (METHODS AND SYSTEMS FOR ELECTRONIC COUPON ISSUANCE TRANSMISSION AND MANGEMENT) has a filing date 11/09/2001 and Claims Priority from Provisional Application 60247104 (11/10/2000).

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of utilizing an electronic coupon. There is no computer or device to analyze or provide the coupon.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claim 8 is deemed to be directed to non statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 recites the limitation "on said server". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-11 and 13-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski (U.S. 5,905,246).

As per claim 1, Fajkowski teaches:

A system for utilizing an electronic coupon, the system comprising a vendor computer device configured to utilize the electronic coupon to provide a benefit;

a purchaser computer device configured to communicate with the vendor computer device at a point of sale (see column 4, lines 15-64); and

a short-range communications device coupled to the purchaser computer device to enable the communication with the vendor computer device at the point of sale (see column 4, lines 15-64).

As per claim 3, Fajkowski teaches:

A system as recited in claim 1, further comprising a secondary computer device configured to transceive the electronic coupon (see column 4, line 63 – column 5, line 38).

As per claim 4, Fajkowski teaches:

A system as recited in claim 1, wherein said secondary computing device is at least one of (i) a server; and (ii) a personal computer (see column 4, line 63 – column 5, line 38).

As per claim 5, Fajkowski teaches:

A system as recited in claim 1, wherein the purchaser computer device comprises at least one of (i) a cell phone; and (ii) a personal digital assistant (see column 6, lines 60-67).

As per claim 6, Fajkowski teaches:

A system as recited in claim 1, wherein the communications device employs wireless communication (see column 6, lines 60-67).

As per claim 7, Fajkowski teaches:

A system as recited in claim 1, wherein at least one of (i) the vendor computer device and (ii) the purchaser computer device is configured to manage the electronic coupon (see column 4, lines 15-64).

As per claim 8, Fajkowski teaches:

In a system that includes a purchaser computer device, a vendor computer device, and an electronic coupon, a method for utilizing the electronic coupon, the method comprising the steps for:

providing the electronic coupon (see column 4, lines 15-64);

determining the validity of using the electronic coupon (see column 4, lines 14-64);

if the electronic coupon is determined to be valid for use, providing a benefit to a user (see column 4, lines 14-64).

As per claim 9, Fajkowski teaches:

A method as recited in claim 8, wherein the electronic coupon is provided from the purchaser computer device to the vendor computer device (see column 4, lines 14-64).

As per claim 10, Fajkowski teaches:

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A method as recited in claim 9, wherein the step for providing comprises at least one of the steps for:

- (i) scanning the electronic coupon (see column 3, lines 50-67);
- (ii) transmitting the electronic coupon via a wireless communication connection (see column 4, lines 6, lines 60-67); and
- (iii) transmitting the electronic coupon via a hard-wired communication connection (see column 6, lines 20-30).

As per claim 11, Fajkowski teaches:

A method as recited in claim 8, wherein the step for determining comprises the step for verifying the identity of the user (see column 4, lines 1-8).

As per claim 13, Fajkowski teaches:

A method as recited in claim 8, wherein the electronic coupon is provided from a secondary computer device (see column 5, lines 15-64).

As per claim 14, Fajkowski teaches:

A method as recited in claim 8, further comprising the steps for:  
determining the validity of using a second electronic coupon; comparing the electronic coupon with the second electronic coupon to determine which electronic coupon is preferred, wherein the benefit provided to the user corresponds to the preferred electronic coupon (see column 19, lines 39-67).

As per claim 15, Fajkowski teaches:

A method as recited in claim 14, wherein the step for comparing includes at least one of the steps for:

- (i) examining an expiration date (see column 19, lines 50-67); and
- (ii) determining which provides a greater benefit (see column 19, lines 50-67).

As per claim 16, Fajkowski teaches:

A method as recited in claim 15, wherein the greater benefit is determined based on at least one of:

- (i) promptness in redemption;
- (ii) frequency of purchase;
- (iii) type of payment employed;
- (iv) one or more products presented for purchase;
- (v) one or more manufacturers of products presented for purchase; and
- (vi) one or more vendors of products presented for purchase (see column 19, lines 15-67).

As per claim 17, Fajkowski teaches:

In a system that includes a first electronic coupon, a first computer device that provides the first electronic coupon, and a second computer device that receives the first electronic coupon, a method for distributing the first electronic coupon, the method comprising the steps for:

providing the first electronic coupon at the first computer device (see column 4, lines 15-64);

selectively transmitting the first electronic coupon from the first computer device to the second computer device to enable a benefit to be provided to a user of the second computer device (see column 4, lines 15-64).



As per claim 18, Fajkowski teaches:

A method as recited in claim 17, wherein the step for providing the first electronic coupon comprises the steps for populating a database on said server with a plurality of downloadable electronic coupons, wherein the first electronic coupon is one of the plurality of downloadable electronic coupons (see column 5, lines 15-65).

As per claim 19, Fajkowski teaches:

A method as recited in claim 18, wherein the step for selectively transmitting comprises the steps for:

providing access to the database (see column 6, lines 20-30);

receiving a request for downloading the first coupon from the data base (see column 6, lines 20-30); and downloading the first electronic coupon to in response to the request (see column 6, lines 20-30).

As per claim 20, Fajkowski teaches:

A method as recited in claim 19, wherein the request is initiated automatically based on preset criteria (see column 6, lines 60-67).

As per claim 21, Fajkowski teaches:

A method as recited in claim 19, wherein the request is selectively initiated by at least one of

- (i) the user (see column 6, lines 60-67);
- (ii) a vendor;
- (iii) a manufacturer of a product; and
- (iv) a provider of a service.

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As per claim 22, Fajkowski teaches:

A method as recited in claim 19, wherein the step for downloading is performed across the Internet (see column 6, lines 20-30).

As per claim 23, Fajkowski teaches:

A method as recited in claim 17, wherein the step for selectively transmitting is performed across a wireless communication (see column 6, lines 60-67).

As per claim 24, Fajkowski teaches:

A method as recited in claim 17, wherein the first electronic coupon is an electronic data file stored locally on the second computer device (see column 6, lines 60-67).

As per claim 25, Fajkowski teaches:

A method as recited in claim 17, wherein the first electronic coupon is an electronic reference location on a network that references the first computer device to a location where the electronic coupon is stored (see column 6, lines 20-30).

As per claim 26, Fajkowski teaches:

A computer program product for implementing within a computer system a method for utilizing an electronic coupon, the computer program product comprising: computer readable medium for providing computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for implementing the steps for:

providing the electronic coupon (see column 4, lines 15-64);

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determining the validity of using the electronic coupon (see column 4, lines 15-64);

if the electronic coupon is determined to be valid for use, providing a benefit to a user (see column 4, lines 15-64).

As per claim 27, Fajkowski teaches:

The computer program product as recited in claim 26, further comprising computer program code means comprised of executable code for implementing the step for tracking information (see column 5, lines 15-64).

As per claim 28, Fajkowski teaches:

The computer program product as recited in claim 26, further comprising computer program code means comprised of executable code for implementing the step for providing a notification relating to the electronic coupon (see column 24, lines 20-55).

As per claim 29, Fajkowski teaches:

A computer program product for implementing within a computer system a method for distributing the electronic coupon, the computer program product comprising: computer readable medium for providing computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for implementing the steps for:

providing the electronic coupon at a first computer device (see column 4, lines 15-64);

selectively transmitting the electronic coupon from the first computer device to a second computer device to enable a benefit to be provided to a user of the second computer device (see column 4, lines 15-64).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US 5,905,246) in view of Kepecs (US 6,330,543).

As per claim 2, Fajkowski teaches:

A system as recited in claim 1, but fails to teach further comprising a biometric input device coupled to the purchaser computer device for positive identification of a user. However, Kepecs teaches a system that uses biometric identification for positive identification of a user (see column 12, lines 5-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Fajkowski would use the Kepec's biometric identification system to allow the provider of the coupon card services to identify each individual to whom a coupon card is registered. Biometric identification would replace the use of identification numbers to positive identify users.

As per claim 12, Fajkowski teaches:

A method as recited in claim 11, but fails to teach wherein a biometric input device is used in performing the step for verifying. The same rejection applied to claim 2 is applied to claim 12.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

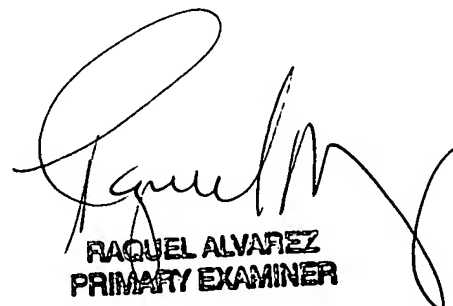
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

The Examiner is scheduled to move to the new Alexandria office in April 2005 (or later). The Alexandria phone number would be 571-272-6720 and RightFax number 571-273-6720. The examiner's supervisor, Eric W. Stamber, new Alexandria number would be 571-272-6724. The current numbers would be in service until the move.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra  
February 25, 2005



RAQUEL ALVAREZ  
PRIMARY EXAMINER